

REMARKS

In the Office Action mailed February 12, 2004, the Examiner rejected claims 1-21. By way of the foregoing amendments and the markings to show changes, Applicants have amended claims 1, 6, 11, 14 and 17 and canceled claims 2 and 19. The amendments to the claims merely put dependent claims in independent format. Thus, none of the amendments causes the Examiner to perform any additional searching by.

I. Claim Rejections 35 USC 103

The Office Action rejected claims 1-21 as being unpatentable over Hill et al. (US patent 6,493,920) in view of Miyazaki et al. (US patent 4,883,310), Hsieh (US patent 5,115,086) and Bhat et al. (US patent 6,133,398). Applicants traverse these rejections. Moreover, Applicants have amended claims 1, 6, 11, 14 and 17 to be in more suitable condition for allowance or for appeal, if necessary.

Claim 1

Claim 1 has been amended to be dependent claim 2 in independent format and claim 2 has been canceled. The Office Action rejected claim 6 stating that, "Official Notice is taken in that it is known to provide roof panels with integral foam-in-place headliners." Applicants suggest, however, that this conclusory statement is inadequate to establish a prima facie case of obviousness.

As stated in the MPEP 2143.03, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." Morevoer, the CAFC has made clear in its caselaw that, "there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant" In re Lee 61 USPQ2d 1430, 1433 referencing In re Fine 5 USPQ2d 1596, 1600 (CAFC 1988), Emphasis Added. The conclusory statement that, "it is known to provide roof panels with integral foam-in-place headliners ..." does not establish that such roof panels with integral foam-in-place headliners are known, nor does the conclusory statement establish any motivation to provide such a headliner to the particular method of claim 1 as presently written.

Claim 6

Claims 6 and 14 have been amended from dependent to independent format. The Office Action rejected claims 6 and 14 stating that, "Official Notice is taken in that it is conventional to provide an automotive windshield with an encapsulation covering such as a sealing gasket." Applicants suggest, however, that this conclusory statement is inadequate to establish a prima facie case of obviousness.

As stated in the MPEP 2143.03, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." Morevoer, the CAFC has made clear in its caselaw, "there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant" In re Lee 61 USPQ2d 1430, 1433 referencing In re Fine 5 USPQ2d 1596, 1600 (CAFC 1988), Emphasis Added. The conclusory statement that, "it is conventional to provide an automotive windshield with an encapsulation..." does not establish that such an encapsulation is known, nor does the conclusory statement establish any motivation to provide such an encapsulation to the particular methods of claims 6 and 14.

Claim 9

With regard to claim 9, Applicants reassert that the Office Actions issued for the present application do not establish a prima facie case of obviousness against claim 9. Both the First Office Action and the most recent Office Action for the present case suggest that Hill et al. discloses adhesive securing of a windshield to a body portion of a vehicle. In the response and amendment of November 13, 2003, Applicant wrote that,

After review of ... sections of Hill et al., Applicants find no mention of adhesively securing a windshield to a body portion of the vehicle. While, Hill et al. may arguably disclose adhesive securing of the pillars 52 and 54, there appears to be no suggestion of adhesively securing the windshield. As such, Applicants suggest that the Office Action fails to assert a prima facie case of obviousness against the present application and the rejection of claims 9-16 should be withdrawn."

In response to this argument, the Office Action reads that, "one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986)." In this instance, however, Applicants contend that this legal citation of In re Keller and In re Merck & Co. lacks merit.

In particular, both In re Keller and In re Merck & Co. deal with situations in which an Applicant for patent has attempted to rebut a prima facie case of obviousness by arguing against a single reference. In the present case, however, Applicants are suggesting that such a prima facie case has never been established. In particular, applicants are suggesting that the assertion by the Office Action that Hill et al. discloses "adhesively securing a windshield to a body portion of the vehicle" appears to be false. Thus, the Office Action does not show all the limitations of the claim as would be required to establish a prima facie case of obviousness. Therefore, In re Keller and In re Merck & Co. are inappropriately applied against the present application.

Claim 11

For Claim 11, the Office Action reads, "...see column 2, line 18 of Hill et al. and column 4, lines 45-48 of Miyazaki et al. Applicant should note that it is known to provide structural foam in roof rail assemblies." This statement again fails to establish a prima facie case of obviousness as it fails to provide any motivation for the "specific combination" of providing such foam in the method of claim 11 as required by In re Lee.

Claim 17

Claim 17 has been amended to be dependent claim 19 in independent format and claim 19 has been canceled. The Office Action rejected claim 19 stating that, "Applicant should note that the provision of additional pillars would depend on the type of vehicle body being assembled and such provision is well within the general knowledge of one of ordinary skill in the art. Applicant should also note that it is conventional to provide an automotive windshield with an encapsulation covering such as a sealing gasket." Applicants suggest, however, that these conclusory statements are inadequate to establish a prima facie case of obviousness.

As stated in the MPEP 2143.03, “To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art.” Morevoer, the CAFC has made clear in its caselaw, “there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant” In re Lee 61 USPQ2d 1430, 1433 referencing In re Fine 5 USPQ2d 1596, 1600 (CAFC 1988), Emphasis Added. The conclusory statement that, “it is conventional to provide an automotive windshield with an encapsulation...” does not establish that such an encapsulation is known, nor does the conclusory statement establish any motivation to provide such an encapsulation to the particular method of claim 17. Moreover, the conclusory statement that, “the provision of additional pillars would depend on the type of vehicle body being assembled and such provision is well within the general knowledge of one of ordinary skill in the art” does not establish that, “connecting the roof portion of the vehicle to a pair of B-pillars and to a pair of C-pillars of the automotive vehicle body” is known, nor does the conclusory statement establish any motivation to provide such “connecting ...” to the particular method of claim 17. Applicants further note that establishment of a prima facie case of obviousness against claim 17 would not only require a showing that such “connecting...” is known, it would also require a specific motivation to combine such “connecting...” with each of the other four references (i.e, Hill et al., Miyazaki et al., Hsieh and Bhat et al.) used to make the rejection.

The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 593-9900.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 04-1512 for any fee which may be due.

Respectfully submitted,

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